

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Reisfeld

Serial No: 09/916,876

Filing Date: 7/30/01

Title: A MODULAR
PHOTOCATALYTIC AIR
PURIFIER

Group Art Unit: 1741

Examiner: Wong, Edna

RESPONSE

Assistant Commissioner for Patents
Washington, DC 20231

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RESPONSE TO THE EXAMINER'S RESTRICTION REQUIREMENT

1. Restriction Requirement:

A. Examiner's Restriction Requirement:

In response to the Office Action dated 12/31/02, designated as Paper No. 9 in the above-captioned application, the Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

Group IA: Claims 1-16, drawn to an air purifier, classified in class 422, subclass 186.3.

Group IB: Claims 17-38, drawn to a fan coil, classified in class 422, subclass 121.

The Examiner asserts that these inventions are unrelated. The Examiner states that "Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §808.01)." The Examiner also asserts that "in the instant case, the different inventions have different effects: one is an air purifier and the other is a fan coil unit with air quality modes."

B. Traversal and Provisional Election:

1. Provisional Election:

The Applicant hereby provisionally elects the subject matter of Group IA, claims 1-16 being drawn to a modular photocatalytic air purifier. This election is made with traverse, to prosecute the claims of group IA. It is understood that the applicant's right to file divisional applications directed to the non-elected subject matter under 35 U.S.C. 120 and 35 U.S.C. 121 is retained.

2. The Restriction Requirement is Improper

The Restriction Requirement is Untimely

The Examiners restriction requirement between Groups I and Group II, and between Species A and Species B above is respectfully traversed as being untimely, unnecessary, and prejudicial to the applicant. **MPEP § 811** states:

37 C.F.R. 1.142(a), second sentence states: “[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner.” This means the Examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the Examiner will consider whether there will be a serious burden if restriction is not required.

MPEP § 811 acknowledges that it is sometimes appropriate for an Examiner to issue a restriction requirement after a first office action on the merits. However, according to **MPEP § 811**, a restriction requirement after a first office action is appropriate only where the restriction after a first office action is made “as soon as the need for a proper requirement develops.” The Applicants interprets **MPEP § 811** to mean that an after-first-action restriction requirement is appropriate only where the applicant amends or adds claim such that restriction requirement is needed in view of the amended or added claims.

In the present application, the Examiner issued an initial Restriction Requirement wherein he identified claims 1-38 as belonging to Group I, and claims 39-45 as belonging to group II. See paper 7, dated October 24, 2002. In paper No. 8, dated November 1, 2002, the Applicants elected the claims of Group I. In paper No. 9, the Examiner now states that Group I should be further divided into Group IA (claims 1-16) and Group IB (claims 17-38).

Applicants respectfully assert that the Examiner's Restriction Requirement is both untimely, and improper on the merits. In order to comply with MPEP § 811, the Examiner should have restricted claims 1-16, 17-38, and 38-45 in the first office action.

The Restriction Requirement is improper

A main policy consideration in allowing Examiners to issue restriction requirements is to relieve Examiners from having to perform searches which are unduly burdensome. The Examiner is respectfully requested, in accordance with MPEP § 811, to explain why it will be a serious burden to examiner claims 1-16 and 17-38 given the fact that independent claim 17 includes all of the limitations of claim 1. If the Examiner performs a search for claim 17, he automatically must perform a search for claim 1. Further, if the Examiner finds that claim 1 is allowable, claim 17 must also be allowable, because claim 1 is the generic claim. Claim 1 and claim 17 are reproduced here for the examiner's convenience.

1. A modular photocatalytic air purifier, the photocatalytic purifier comprising:
 - a modular enclosure having a retractable alignment mechanism, the retractable alignment mechanism being configured to move between an in-use position and a retracted position;
 - a plurality of support structures disposed within the modular enclosure, each of the plurality of support structures having a catalytic layer disposed thereon; and
 - at least one UV lamp interposed between the plurality of support structures.
17. A fan coil unit including an air return, a coil unit, a fan, and an air supply, the fan coil unit comprising:
 - at least one photocatalytic purifier disposed adjacent the coil unit, the at least one photocatalytic purifier including,
 - a modular enclosure having a retractable alignment mechanism, the retractable alignment mechanism being configured to move between an in-use position aligned within the fan coil unit and a retracted position,

a plurality of support structures disposed within the modular enclosure,
each of the plurality of support structures having a catalytic layer
disposed thereon, and
at least one UV lamp interposed between the plurality of support
structures; and
a control unit coupled to the at least one photocatalytic purifier, whereby the
control unit energizes the at least one UV lamp in accordance with a
fan coil operating mode.

A cursory comparison of claim 1 with claim 17 reveals that the “at least one photocatalytic purifier” recited in claim 17 is virtually identical to the subject matter of claim 1.

Second, MPEP 802.01 states that “the Commissioner may require Restriction if two or more ‘independent and distinct’ inventions are claimed in one application.” The term independent means “there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect...” Claim 1 and claim 17 cannot be independent because there is a disclosed relationship between the two or more disclosed subjects. Namely, the “at least one photocatalytic purifier” recited in claim 17 is identical to the subject matter of claim 1. The term distinct means that, while two subjects may be related, for example, as combination and part thereof, which is the case here, they also must be PATENTABLE OVER EACH OTHER (e.g., novel and unobvious). In this case, claim 1 is not patentable over claim 17 because the “at least one photocatalytic purifier” recited in claim 17 is identical to the modular photocatalytic air purifier recited in claim 1.

If Examiner insists on maintaining the Examiner’s Restriction Requirement, a serious prejudicial affect would be incurred by the applicant. If applicant is to face the burden of separate examination fees, separate legal fees, separate issue fees, separate administrative fees, and separate maintenance fees as to separate patents for each of claims 1, 17, and 39, the applicant could have been and should have been advised of that potential burden right from the onset.

Finally, the Examiner asserts in paragraph 5 of his Office Action that the Restriction Requirement is proper because the “search required for Group IA is not required for Group IB. The Applicants have pointed out in the above discussion that the search required for Group IA is required for Group IB. Which is another reason why the Examiner’s Restriction Requirement is improper.

Applicant is confident that the Examiner will withdraw the restriction requirements of the previous office action in light of the arguments presented herein. If the restriction requirements are not withdrawn, applicants intend to petition until the restriction requirements are properly withdrawn. Applicant provisionally elects Group IA in the unlikely event that the restriction requirement of the previous action is not withdrawn.

2. Election of Species

A. Examiner's Election of Species Requirement

In paragraph 6 of his Office Action, the Examiner states that the instant "application contains the following patentably distinct species of the claimed invention: claims 3-6, 10, 11, 21-24, 34 and 35 recite the material of the plurality of support structures." The Examiner also states that "independent claim 1 or claim 17 is generic."

B. Provisional Election and Traversal:

The Applicant assumes that, because the inventor identifies claim 1 and claim 17 as being generic, claims 1 – 16 are linked and claims 17-38 are linked. Thus, as stated above, the Applicant hereby provisionally elects the subject matter of Group IA, claims 1-16 being drawn to a modular photocatalytic air purifier. This election of species is made with traverse. It is understood that the applicant's right to file divisional applications directed to the non-elected subject matter under 35 U.S.C. 120 and 35 U.S.C. 121 is retained.

B. The Election of Species Requirement is Improper on the merits

Applicants traverse the restriction requirement on the grounds that the Examiner's restriction requirement under MPEP 809.02 does not satisfy the requirements for a restriction requirement specifically set forth in MPEP 809.02 (a). MPEP 809.02 (a) (B) specifically directs an Examiner to:

Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

In spite of MPEP 809.02(a) specifically requiring an Examiner to "clearly identify" each species to which claims are restricted, the Examiner made no bona fide effort, in the restriction requirement of December 31, 2002 to identify the species to which the claims are to be restricted. The Examiner's purported attempt to clearly identify each species of applicants invention consisted of the statement: the "application contains the following patentably distinct species of the claimed invention: claims 3-6, 10, 11, 21-24, 34 and 35 recite the material of the plurality of support structures."

Listing sets of dependent claims does not amount to *clearly identifying* species as required by MPEP 809.02(a). In fact, the mere listing of these dependent claims does nothing whatsoever to advance the inquiry into whether more than one species is claimed in an application. The Examiner's purported effort to "clearly identify" the various species to which the claims are to be restricted is unintelligible. First, the applicant asks if the listed claims are one species while the claims not listed form another species? Or, if each claim set separated by a comma is deemed by the Examiner to be a separated species, is the Examiner suggesting that the applicant forgot about claims 2, 7-9, 12-20, 25-33, and 36-38? The Applicants have come to believe that the Examiner does not understand the difference between a dependent claim and a species. It is common practice to claim alternate materials and alternate structures in dependent claims. To suggest that each alternate material and structure results in a "genus-species" is contrary to well established practice. Claim 3 recites that a ceramic material is employed. Claim 10 recites that a "honey-combed material" is used. Could it not be true that the material could be both ceramic and honey-combed? The point is, that dependent claims are used for the very purpose of claiming minor material variations.

The Examiner makes no effort to take any of the steps which are stated in MPEP 809.02(a) that illustrate a bona fide effort to clearly identify each claimed species of the application. As noted above, the MPEP states that "the species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively." To the contrary, the Examiner's incomplete list of dependent claims does not qualify as a bona fide attempt to identify each species by way of drawings. The Examiner has not even gone so far as to identify an exemplary species of the claimed invention, which is the recommended course of action in "aggravated cases" where each species cannot be identified. The Examiner also does not attempt to identify species in terms of examples as suggested by MPEP 809.02(a). Further, the Examiner makes no attempt, in the absence of figures or

examples, as is required by MPEP 809.02(a), to point out "the mechanical means, the particular means, or other distinguishing characteristic" of each identified species.

In view of the fact that the Examiner has failed to comply with the requirement specifically stated in MPEP 809.02(a), that the Examiner "clearly identify" the species to which the claims are to be restricted, it is respectfully requested that the restriction requirement pursuant to MPEP 809.02(a) be withdrawn.

3. Conclusion

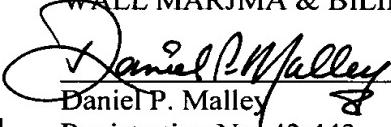
If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-0289.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

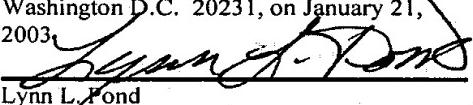
Respectfully submitted,

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Date: January 21, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail addressed to the Assistant Commissioner for Patents, Washington D.C. 20231, on January 21, 2003.


Lynn L. Pond